



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,780	12/28/2004	Tomoyuki Asano	262954US6PCT	7690
22850	7590	07/08/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
NILFOROUSH, MOHAMMAD A				
ART UNIT		PAPER NUMBER		
3685				
NOTIFICATION DATE		DELIVERY MODE		
07/08/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
oblonpat@oblon.com  
jgardner@oblon.com

### Office Action Summary

**Application No.**

10/517,780

**Applicant(s)**

ASANO, TOMOYUKI

**Examiner**

Mohammad A. Nilfroush

**Art Unit**

3685

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-33 and 37-42 is/are pending in the application.
- 4a) Of the above claim(s) 5-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. The amendment filed 12 March 2009 is acknowledged.
2. Claims 37-42 are pending.
3. Claims 37-42 have been examined.
4. This Office action is given Paper No. 20090629 for reference purposes only.

### ***Response to Amendment/Arguments***

5. Applicant's arguments with respect to claims 37-42 have been considered but are moot in view of the new ground(s) of rejection.

### ***Examiner's Comments***

6. Applicant's claims employ language that does not serve to differentiate the claims from the prior art.
7. Claims 37, 39, and 41 recite "...verifying the identification data *if* the verification data is the same as the message data of the identification data recorded on the assigned recording media..." and "...writing an encrypted content to the assigned recording media using a media recording device *if* the assigned recording media is verified in the comparing..." Thus, the step of "...verifying the identification data..." is conditional on the verification data being the same as the message data of the identification data recorded on the assigned recording media. Further, the step of "...writing an encrypted content to the assigned recording media..." is conditional on the

assigned recording media being verified in the comparing. Additionally, claims 38, 40, and 42 recite "...the media recording device is further configured to inhibit writing the encrypted content to the assigned recording media *if* the identification data recorded on the assigned recording media is included in the identification revocation list..." Steps that may or may not be performed do not serve to differentiate the claims from the prior art. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally performed under certain other hypothetical scenarios. (*In re Johnston*, 77 USPQ2d 1788 (CA FC 2006); *Intel Corp. v. Int'l Trade Comm'n*, 20 USPQ2d 1161 (Fed. Cir. 1991); MPEP §2106 II C).

### ***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 37-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

10. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular

apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, claim 37 fails prong (1) because the "tie" (e.g. "using a data processing device") is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim 38 is also rejected as each depends from claim 37.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asano, et al. (European Patent Application Publication No. EP 1069567, hereinafter "Asano") in view of Muehring (US Patent Application Publication No. 2003/0145183).

13. Regarding claims 37, 39 and 41, Asano discloses a method of a media verification system for identifying recording media, comprising:

- generating a plurality of different signature data from secret key data and message data using a data processing device of the media verification system (Asano Paragraphs 37, and 115);
- generating a plurality of different identification data using the data processing device, each of the plurality of different identification data including a generated signature data and a message data used in the generating of the generated signature data (Asano Paragraphs 37, and 115);
- *assigning one of the plurality of generated identification data to each of a plurality of different recording media (Asano Paragraphs 27-28, 37, 43, and 115);*
- recording one of the plurality of generated identification data to an assigned recording media using a media writing device of the media verification system (Asano Paragraph 28, 39, 43, and 115);
- generating verification data from the generated signature data of the identification data recorded on the assigned recording media using a public key (Asano Paragraphs 35, 46, 51-60 and 115);
- comparing the verification data to the message data of the identification data recorded on the assigned recording media using the data processing device and

verifying the identification data if the verification data is the same as the message data of the identification data recorded on the assigned recording media (Asano Paragraphs 55-60);

- writing an encrypted content to the assigned recording media using a media recording device if the assigned recording media is verified in the comparing, wherein the media recording device is configured to inhibit writing the encrypted content to a recording media having an unverified identification data or no identification data recorded thereon (Asano Paragraphs 61, 72, 81-82, 90-92, and 115; Claim 1).

Asano does not specifically disclose storing the plurality of different identification data in an electronic memory of the media verification system.

Muehring discloses storing the unique identification information stored on each disc on a server (Muehring Paragraph **18**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method of Asano to include storing the unique identification information stored on each disc on a server as disclosed in Muehring in order to track where the disc is recorded and make sure data is only recorded on valid discs (Muehring Paragraphs **18-20**).

14. Regarding claims 38, 40, and 42, Asano discloses:

- generating an identification revocation list, wherein the identification revocation list includes identification data (Asano Paragraphs **41-42**);

- recording the identification revocation list to the assigned recording media using the media writing device, wherein the media recording device is further configured to inhibit writing the encrypted content to the assigned recording media if the identification data recorded on the assigned recording media is included in the identification revocation list (Asano Paragraphs **43**, **53-55**).

Asano does not specifically disclose that the identification data on the revocation list corresponds to an unauthorized recording media.

Muehring further discloses storing disc IDs on a server and marking pirated copies as such (Muehring Paragraphs **18** and **33**).

### ***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad A. Nilforoush whose telephone number is (571)270-5298. The examiner can normally be reached on Monday-Thursday 8 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. A. N./  
Examiner, Art Unit 3685

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685